

### **REMARKS/ARGUMENTS**

Reexamination and reconsideration of this application, withdrawal of the rejections, and formal notification of the allowability of all claims as now presented are earnestly solicited in light of the above claim amendments and remarks that follow. Claims 1-7, 10-15, 17, 19-21, 24, 26, and 31-37 are pending in the present application.

Claims 1, 3-7, 10-14, 17, 19-21, 24, 26, and 32-37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,908,687 in view of U.S. Patent No. 4,260,703. Applicants respectfully traverse this rejection.

Applicant respectfully submits the Examiner has failed to show proper motivation for combining the cited references. In the Advisory Action dated May 19, 2006, the Office alleges the references are properly combinable, particularly arguing that the invention of the '703 patent is concerned with solving the same problem as the present Applicants. Applicants respectfully submit, however, that such an argument only illustrates the use of impermissible hindsight and does not point to anything in the '703 patent that would motivate a skilled artisan to combine the teachings of the '703 patent with the '687 patent.

The '703 patent discloses urethane-acrylate compositions that can be used as radiation-curable coating compositions to avoid the use of solvents. The remainder of the '703 patent is dedicated to describing various compounds and methods to form its urethane-acrylate compositions. Thus, the '703 patent only teaches that radiation-curable coating compositions are a desirable alternative to environmentally unfriendly compositions relying on solvents. The '703 patent nowhere provides any teaching or suggestion of specific possible uses for such composition, and it certainly provides no motivation to use the coating in the preparation of a stencil master.

The desire to improve strength through cross-linking is the only connection between the two references suggested by the Office. However, the Office admits the '687 patent makes no mention of cross-linking. Absent such a necessary nexus, Applicants submit there can be found no motivation in the '687 patent to seek out other methods to increase strength. The '687 patent already teaches a method to increase strength through incorporation of fibers. To suggest seeking out other methods of increasing strength would be to teach its fiber method is insufficient. Accordingly, Applicants can see no motivation in the teaching of the '687 patent to

seek out further methods of increasing strength, such as cross-linking. It certainly does not suggest seeking out radiation curable methods.

Not only is there lack of motivation to combine the references, Applicant submits the references actually teach away from such a combination. In particular, Applicant submits a skilled artisan armed with the disclosure of the '687 patent and the '703 patent would recognize that the underlying chemistry of the two disclosures is actually incompatible. The Office argues there is no factual evidence of such incompatibility. Applicants submit, however, such would be understood in the art.

The '687 patent uses a resin capable of incorporation into a volatile liquid that, when foamed, can be dried to form a solid foam (see column 5, lines 53-65 of the '687 patent). The '703 patent nowhere discloses the use of foam coatings and, in light of the teaching of the '703 patent against using solvents, no method of making foam absent the use of solvents is provided by the combined references.

Moreover, since the '703 patent excludes the use of solvents, its resins are liquid. A skilled artisan would recognize that a foamed composition of such liquid resins would lack stability and would begin collapsing immediately after foam formation. Such a foamed coating would not be suitable for the purpose of the '687 patent, that being to form a heat-sensitive stencil. A skilled artisan would immediately recognize these deficiencies and would not be motivated to combine the references and would rather disregard the '703 patent as teaching compositions incompatible with the objects of the '687 patent.

A skilled artisan would also recognize that any liquid foam created in the absence of a volatile solvent would be expected to have thick cell walls. Such thick cell walls, however, are opposite what is required in a stencil master or stencil of the type used in digital duplication. To function as a stencil, it is necessary that the foam coating have thin cell walls to allow passage of ink without blocking the image holes formed in the underlying heat-sensitive polymeric film. Thick cell walls would be expected to block these image holes, rendering the stencil useless. Accordingly, the skilled artisan would avoid combination of the teachings of the '687 patent and the '703 patent for this reason also.

In light of the above, Applicants submit there is a lack of motivation to combine the references, and any attempt to combine the references would not result in the presently claimed

invention. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the present rejection.

Claim 2 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,908,687 in view of U.S. Patent No. 4,260,703 and U.S. Patent No. 4,082,887. Claim 15 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,908,687 in view of U.S. Patent No. 4,260,703 and U.S. Patent No. 3,804,700. Claim 31 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,908,687 in view of U.S. Patent No. 4,260,703 and U.S. Patent No. 6,357,347 (cited as an English equivalent of JP 11-179699). Applicant respectfully traverses this rejection.

Applicants respectfully submit the statements provided above are equally pertinent to the present rejections. Moreover, the inclusion of the further references fail to cure the deficiencies in the combination of the '687 patent and the '703 patent. In particular, the Office has failed to show any motivation for combining the references to arrive at the present invention, and the Office has failed to recognize that the '687 patent and the '703 patent disclose incompatible compositions and a skilled artisan would not attempt to make the alleged combination. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the present rejection.

For the reasons provided above, Applicants respectfully submit all claims are in condition for allowance. Accordingly, Applicant respectfully requests that all rejections be withdrawn and a Notice of Allowance be issued in due course. If any minor informalities need to be addressed, the Examiner is directed to contact the undersigned attorney by telephone to facilitate prosecution of this case.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR §1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

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